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EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

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10/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply; if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,468	Applicant(s) BUCHI, BRYAN M.	
	Examiner William V. Gilbert	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) 6-20, 27-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 29-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>14 August 2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3635

DETAILED ACTION

This is a Final Office Action. Claims 6-20 have been cancelled. Claims 27-34 are withdrawn from consideration for the reasons set forth below. Claims 1-5 and 21-34 are pending.

Election/Restrictions

1. Newly submitted claims 29-34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to a method for making the product classified in class 249.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Further Claims 27 and 28 are withdrawn from consideration as being dependent from cancelled Claim 12.

Art Unit: 3635

Drawings

2. The drawings were received on 14 August 2007. These drawings are objected to because they do not comply with 27 C.F.R. §1.121(d) in that the drawing is not labeled "Replacement Sheet" as required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 22 claim (e.g. Claim 1, lines 7 and 8) that a colorant is incorporated as part of a matrix, while the disclosure as filed did not provide such a limitation. Regarding Applicant's statement (Remarks filed

Art Unit: 3635

14 August 2007: pages 11 and following) that the colorant is included in the matrix is an inherent feature, the Examiner respectfully disagrees in that the Applicant discloses that the material is painted, not colored which is a different way to provide color.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-5, 21-23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price (U.S. Patent No. 6,691,471) in view of Eyring (U.S. Patent No. 6,219,982).

Claim 1: Price discloses an artificial cover comprising a first side (Fig. 2: 33) with a three-dimensional rock pattern (see Fig.) the pattern includes a plurality of rock-shaped protrusions (20) extending from the first side at acute angles (see portions 21 extend at acute angles) a second side (22) configured to attach to the underlying structure, the cover has sufficient rigidity to prevent sagging (an inherent feature) and the cover does not include a liner in the matrix (as best understood by the Examiner in light of the Specification). While Price does not disclose a coloring the material, it does disclose that the material may be made of plastic (Col 5: lines 40-45), which are known for being colored during the manufacture process. Eyring discloses a plastic member that is formed with a color in the matrix (Col. 1, lines 60 and following). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to impregnate the plastic material in Price with the coloring as in Eyring because impregnated coloring lasts

Art Unit: 3635

longer than a painted surface and is typically more aesthetically pleasing.

Claims 3 and 25: the underlying structure is a foundation of a home (Price: Fig. 1).

Claim 4: While Price discloses the claimed invention including a staircase (Fig. 1), it does not disclose the cover covering the staircase. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to cover the staircase with a covering as well in order to make the overall structure more aesthetically pleasing.

Claims 5 and 26: Price discloses the cover attached to the underlying structure with screws (Col. 5: lines 12-15).

Claim 21: the upper portions of the protrusions (Price: 23c) extend from the first side at acute angles (see Fig. 5 for a cross section where the portion is at an acute angle.)

Claim 22: Price discloses an artificial cover for covering an underlying structure comprising a first side (33) with a three-dimensional rock pattern (20) protruding from the first side and a second side (22) configured to contact and attach to the underlying structure, the cover has sufficient rigidity to prevent sagging upon securing to

Art Unit: 3635

the underlying structure, and the cover does not include a liner in the matrix (as best understood by the Examiner in light of the Specification.) While Price does not disclose a coloring the material, it does disclose that the material may be made of plastic (Col 5: lines 40-45), which is known for being colored during the manufacture process. Eyring discloses a plastic member that is formed with a color in the matrix (Col. 1, lines 60 and following). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to impregnate the plastic material in Price with the coloring as in Eyring because impregnated coloring lasts longer than a painted surface and is typically more aesthetically pleasing.

Claim 23: the rock pattern has a plurality of rock-shaped protrusions extending from the first side (20) and they extend outward at acute angles (see portions 21 and 23c that extend at acute angles.)

Claims 2 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Eyring as applied to claims 1 and 22 respectively above, and further in view of Trouselek (U.S. Patent No. 5,465,545).

Art Unit: 3635

Claims 2 and 24: Price in view of Eyring discloses the claimed invention including that the panel can be made of plastic (Col. 5, line 45), but not that the cover is polyurethane. Trousilek discloses a panel made of plastic including polyurethane (Col. 7, lines 50-55). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the panel out of polyurethane because polyurethane is a plastic and would perform equally as well with the plastic in Price.

Response to Arguments

5. The following addresses Applicant's remarks dated 14 August 2007.

Applicant's arguments filed 14 August 2007 have been fully considered but they are not persuasive. Applicant's cancellation of Claim and rewriting as Independent Claim 29 overcomes the 35 U.S.C. §112 rejection; however, by placing the claim in independent form now falls under a new classification and a restriction is required (See Above).

Art Unit: 3635

Applicant's argument for the lack of new matter (Remarks: page 11) is not persuasive for reasons set forth above.

Lastly, the Applicant submitted arguments regarding a Rygiel reference. The arguments are moot however because the Examiner did not cite nor use the Rygiel reference as prior art in any form.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3635

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Barry Kelt
05/11/2007
Pam/ESL
10/26/07

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG

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26 Oct 04